

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of)	
)	For: VIRTUAL NEGOTIATION
Mitchell B. OLIVER, et al.)	
)	
)	
Serial No. 10/062,117)	
)	
Filed: January 30, 2002)	Group No. 3684

REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

Further to the concurrent filing of the attached Notice of Appeal, and responsive to the final Office Action issued on 5/12/2010, the following remarks are submitted in connection with the above-identified patent application under the Pre-Appeal Brief Review program. Claims 1-3, 5, 6, and 8-23 are pending in the current application. Claims 1, 5, 8, 11, and 14-19 are independent claims.

MATERIAL UNDER REVIEW

- The machine-or-transformation test is no longer sufficient to determine whether claims are non-statutory based on a Supreme Court ruling issued on 6/28/2010.**

In the 5/12/2010 Final Office Action, the Examiner maintained the rejection of claims 1-3, 8-10, 14-16 and 18-23 under 35 U.S.C. § 101 based on the machine-or-transformation test, which the Examiner articulated as follows:

Claims 1-3, 8-10, 14-16, and 18-23 are rejected under 35 U.S.C. 101. Based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. (*e.g., see Page 5 of the 05/12/2010 Office Action*)

Effective 6/28/2010, the machine-or-transformation test is no longer the exclusive test for determining patent eligibility for processes under 35 U.S.C. § 101. The Appellants direct the

Pre-Appeal Brief Review group to (*Bilski v. Kappos*, U.S., No. 08-964, 6/28/10), which can be found at <http://www.supremecourt.gov/opinions/09pdf/08-964.pdf>. Justice Kennedy, writing the opinion of the Court, states the following regarding the machine-or-transformation test:

(b) The machine-or-transformation test is not the sole test for patent eligibility under §101. The Court's precedents establish that although that test may be a useful and important clue or investigative tool, it is not the sole test for deciding whether an invention is a patent-eligible "process" under §101. In holding to the contrary, the Federal Circuit violated two principles of statutory interpretation: Courts " 'should not read into the patent laws limitations and conditions which the legislature has not expressed,' " *Diamond v. Diehr*, 450 U. S. 175, 182, and, "[u]nless otherwise defined, 'words will be interpreted as taking their ordinary, contemporary, common meaning,' " *ibid.* The Court is unaware of any ordinary, contemporary, common meaning of "process" that would require it to be tied to a machine or the transformation of an article. Respondent Patent Director urges the Court to read §101's other three patentable categories as confining "process" to a machine or transformation. However, the doctrine of *noscitur a sociis* is inapplicable here, for §100(b) already explicitly defines "process," *see Burgess v. United States*, 553 U. S. 124, 130, and nothing about the section's inclusion of those other categories suggests that a "process" must be tied to one of them. (*Bilski v. Kappos*, U.S., No. 08-964, *Emphasis added*)

Accordingly, the machine-or-transformation test is merely one way to show patent eligibility, but is not the exclusive test. Therefore, failing the machine-or-transformation test is insufficient grounds to invalidate a claim as corresponding to non-statutory subject matter under 35 U.S.C. § 101.

For these reasons, the above-noted rejection is clearly incompatible with both the spirit of the law and the explicit precedent articulated by the Supreme Court and therefore must be withdrawn.

2. Claims 1-3, 8-10, 14-16, and 18-23 satisfy the machine-or-transformation test.

The Supreme Court holding discussed in the preceding section indicated that subject matter cannot be deemed non-statutory by failing the machine-or-transformation test, but also indicated that the machine-or-transformation test remains a valid manner of showing that claims are statutory.

Regarding claims 1-3, 8-10, 14-16 and 18-23, the Office indicates that the rejected claims are not "tied to a machine and can be performed without the use of a particular machine" (e.g., see Page 3 of the 5/12/2010 Final Office Action).

Firstly, the machine-or-transformation test has never suggested that each and every claim feature be performed with a machine, but rather that the claim on a whole should be tied to a machine. With this in mind, claim 1 recites “a “method, performed by a communications device”” (Emphasis added), claim 8 recites “receiving, at the communications device”” (Emphasis added) and claim 18 recites “providing, at the communications device”” (Emphasis added).

Secondly, claims 14 and 19 are not even directed to processes, but are rather directed to a “non-transitory computer-readable medium[s]”, and should not have been rejected under the machine-or-transformation test in any case because claims 14 and 19 are directed to apparatus.

The human mind is not a “communications device,” nor is the human mind a “non-transitory computer-readable medium.” As such, claims 1-3, 8-10, 14-16, and 18-23 satisfy the machine-or-transformation test.

In view of the foregoing remarks, the Appellants respectfully request withdrawal of this rejection.

3. The Office is forbidden to read means-plus-function claims upon mere software.

Claims 1-3, 5, 6 and 8-23 remain rejected under 35 U.S.C. § 101 as allegedly being directed to non-statutory subject matter. The Appellants respectfully traverse this rejection.

Regarding claims 5, 6, 11-13 and 17, the Office indicates that these claims are simply a system defined by software (e.g., see Page 2 of the 5/12/2010 Final Office Action). As such, the Office is attempting to read a means-for claim invoked under 35 U.S.C. § 112, 6th paragraph upon software-code. However, 35 U.S.C. § 112, 6th prohibits the Office from making this interpretation. 35 U.S.C. § 112, 6th paragraph recites the following:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. *(e.g., see 35 U.S.C. § 112, 6th paragraph, Emphasis added)*

As will be appreciated, the Office is not permitted to read a claim under 35 U.S.C. § 112, 6th paragraph upon mere program code or functional language, but is required by law to read such a claim upon corresponding “structure, material, or acts,” each of which corresponds to a statutory category of invention. Accordingly, so long as there is support for corresponding

“structure, material or acts” in the Specification (see preceding section, this support is implicit/inherent), the Office is required to read this claim upon the statutory subject matter.

Reading claims under 35 U.S.C. § 112, 6th paragraph upon non-statutory software is not in the Office’s discretion. Therefore, the issue becomes whether there is adequate support in the Specification to support a statutory interpretation of the means-for claims. This analysis does not fall under 35 U.S.C. § 101. Thus, even if the Office alleges there to be no support for a statutory interpretation of the rejected claims, the Office still needs to withdraw the 35 U.S.C. § 101 rejection.

In view of the foregoing remarks, the Appellants respectfully request withdrawal of this rejection.

4. Claims 5-6, 11-13 and 17 are means-plus-function claims pursuant to 35 U.S.C. § 112, 6th Paragraph and are supported by the Specification.

Claims 5, 6, 11-13 and 17 are rejected under 35 U.S.C. § 112, 2nd Paragraph as allegedly being indefinite. The Appellants respectfully traverse this rejection.

The Office indicates that the written description only “discloses the general purpose computer but fails to disclose corresponding structure, material, or acts for performing the steps of ‘receiving, presenting, associating, offering, etc.’ ” (e.g., see Page 2 of the 5/12/2010 Final Office Action, Emphasis is the Office’s). The Appellants believe that the Office is misinterpreting the requirements of 35 U.S.C. § 112, 2nd Paragraph.

Firstly, this rejection appears to question the written-description support for claims 5, 6, 11-13 and 17. Such a rejection should be asserted under 35 U.S.C. § 112, 1st Paragraph, not 35 U.S.C. § 112, 2nd Paragraph. Secondly, assuming this rejection was asserted under 35 U.S.C. § 112, 1st Paragraph, the Appellants submit that sufficient description has been provided in the Specification for the rejected claims, as will now be explained.

A “means for receiving” can correspond to a receiver, a “means for presenting” can correspond to some type of user-display, and so on. As noted by the Office on Pages 3-4 of the 9/18/2009 Office Action:

If applicant is of the opinion that the written description of the specification already implicitly or inherently discloses the corresponding structure, material, or acts so that one of ordinary skill in the art would recognize what structure, material, or acts perform the claimed function, applicant is required to clarify the record by either:

- (a) Amending the written description of the specification such that it expressly recites the corresponding structure, material, or acts for performing the claimed function and clearly links or associates the structure, material, or acts to the claimed function, without introducing any new matter (35 U.S.C. 132(a)); or
- (b) Stating on the record what the corresponding structure, material, or acts, which are implicitly or inherently set forth in the written description of the specification, perform the claimed function. For more information, see 37 CFR 1.75(d) and MPEP §§ 608.01(0) and 2181.

Pursuant to option (b) presented above, the Appellants respectfully submit that the structure upon which each “means for” feature reads is either implicitly or inherently disclosed in the Specification. For example, phone 120 as illustrated in FIG. 1 implicitly and/or inherently includes a receiver and transmitter, some type of display mechanism and a user input mechanism (e.g., a touch screen, keypad, etc.). Likewise, the application download servers shown in FIG. 2 implicitly and/or inherently include some type of receiver for receiving network data.

The Appellants respectfully request that the Office withdraw this rejection.

CONCLUSION

In light of the remarks contained herein, the Appellants respectfully submit that the application is in condition for allowance, for which early action is requested.

Please charge any fees or overpayments that may be due with this response to Deposit Account No. 17-0026.

Respectfully submitted,

Dated: August 11, 2010

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